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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD M. BUSWELL and ERIC J. MORIN

Appeal 2008-0225
Application 10/065,729
Technology Center 2100

Decided: June 3, 2008

Before JAMES D. THOMAS, ALLEN R. MACDONALD,
and THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-20 under 35 U.S.C. § 134(2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellants, the invention is an implementation of a client-server text messaging (CSTM) monitor installed on a computer system that is configured to monitor a client-server text messaging (CSTM) server for commands posted thereto, and a management program installed on the computer system which is responsive to the commands. The CSTM monitor is lightweight and allows multiple computer systems to monitor a CSTM server and execute posted commands. Managed computer systems are more efficient because the management program does not run continuously. The commands are text-based and, therefore, require very little network bandwidth between a management system and the managed computer system. The invention allows a centralized computer management system to monitor managed computer systems and implement corrective measures without overburdening the systems or network bandwidth (Spec., Abstract).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A system for performing remote computer system management, the system comprising:

a client-server text messaging (CSTM) monitor installed on a computer system, the monitor configured to monitor a CSTM server for a command from a management system posted thereto; and

a management program installed on the computer system which is responsive to the command from the management system.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Wick	US 6,691,162 B1	Feb. 10, 2004
MacGregor	US 2005/0102382 A1	May 12, 2005
		(Filed Jun. 4, 2001)

Claims 1-7, 9-12, 14-18, and 20 stand rejected under 35 U.S.C. § 102(e) over the teachings of Wick; and

Claims 8, 13, and 19 stand rejected under 35 U.S.C. § 103(a) over the teachings of Wick and MacGregor.

We affirm.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that

A. Claims 1-7, 9-12, 14-18, and 20 are unpatentable under 35 U.S.C. § 102(e) over the teachings of Wick; and

B. Claims 8, 13, and 19 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Wick and MacGregor.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Wick

1. Wick discloses detecting whether a previously unavailable user is available to receive messages, and automatically sending a predetermined message, such as an instant message, to the previously unavailable user upon detecting that the user has become available. Notification is provided to a monitoring user that the previously unavailable user has become available and/or that the predetermined message was sent. An instant message window is initiated on a computer screen of the monitoring user. A command specified by the monitoring user may be executed upon detecting the previously unavailable user's availability (col. 2, l. 63 to col. 3, l. 12).
2. Wick discloses a method of pouncing (taking one or more specified actions such as sending a message, emitting an audible or visual notification, executing a command, etc.), wherein a first user sets up the parameters of the pounce in step 50. Typical parameters that could be specified include the identity of the pounce (specified by, e.g., signon ID, name, email address, etc.); the event that triggers the pounce (e.g., pouncee's signing on to system, pouncee's sending an

IM to a specified party, detection of being added to or deleted from the pouncee's buddy list, etc.); the action or actions that are to be taken (e.g., send an IM,; send a chat invitation, audible or visual notification, execute a specified command); and whether the pounce should occur only once or upon each separate detection of the specified trigger event. Then, the next step is to wait for occurrence of the specified event in step 52, for example, a detection that a specified user has signed on to the computer service. This detection can occur either at the client system or in conjunction with a server on the network. Upon occurrence of the specified event, the pounce is executed in step 53. (Col. 5, ll. 1-55; Fig. 5).

IV. PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). "Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (citations omitted).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The *claims* measure the invention. *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

V. ANALYSIS

35 U.S.C. § 102(e)

Appellants do not provide separate arguments with respect to the rejection of independent claims 1, 10, and 14, and claims 2-7, 9, 11, 12, 15-18, and 20 depending therefrom. Therefore, we select independent claim 1 as being representative of the cited claims. Consequently, these claims fall together with representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

In the Appeal Brief, Appellants argue that “Wick does not disclose the monitoring/monitor feature of the claimed invention” because “in the claimed invention, the CSTM monitor is configured to monitor a command from a management system different than the computer system where the CSTM monitor is located.” (App. Br. 4). According to Appellants, “the management system (targeted user) [in Wick] performs a passive specified event, but it does not issue a command.” (App. Br. 6).

We disagree. Appellants’ argument that Wick differs from the claimed invention because “in the claimed invention, the CSTM monitor is configured to monitor a command from a management system different than the computer system where the CSTM monitor is located” is not commensurate with the claimed invention. The “management system” and “computer system” cannot be confined to a specific embodiment set forth in Appellants’ Specification. Appellants’ claims simply do not place any limitation on what the “management system” or the “computer system” is to be, to represent, or to mean, other than that a monitor installed on a

computer system is configured to monitor a command from the management system.

We agree with the Examiner's position as to Wick disclosing the "management system" and "computer system" beginning at page 4 of the Answer and the Examiner's corresponding responsive arguments beginning at page 7 of the Answer. The Examiner found that "[t]he language of the claim does not prohibit monitoring to be performed from a client computer." (Ans. 8).

Wick discloses whether a monitored user's availability to receive messages is detected, and notification is sent to a monitoring user upon detecting that the monitored user has become available. (FF 1-2). We agree with the Examiner that such notification to the monitoring user is a receipt by a monitor in a computer system of a command from a management system.

As to Appellants' argument that the management system of Wick "does not issue a command" (App. Br. 6), we agree with the Examiner's position as to Wick disclosing such a "command" beginning at page 4 of the Answer and the Examiner's corresponding responsive arguments beginning at page 7 of the Answer.

Wick discloses sending a notification to a monitoring user and initiating an instant message window on the computer screen of the monitoring user upon detecting that a monitored user has become available. (FF 1-2). We agree with the Examiner that "[o]ne of ordinary skill in the art

applying the broadest reasonable interpretation in the environment disclose[d] by [A]ppellant[s] to the terminology ‘command’ would construe this terminology to correspond to [a] message posted on a se[r]ver regarding the status of the user from a computer system.” (Ans. 7). That is, an ordinary artisan would have understood that the notification regarding the status of the user with the initiation of the instant message window is a command from the monitored system to take action in response to the status message.

In the Reply Brief, Appellants add the argument that “a command is an active instruction to do something, instead of just a message regarding the status.” (Reply Br. 1). However, as discussed above, one of ordinary skill in the art would have understood that the status notification is a command from the monitored system to the monitoring system to respond.

Appellants also argue that that “Wick does not disclose the management feature of the claimed invention” because “[t]he specification of the current invention further describes management as ‘to evaluate, monitor and correct problems on [a] managed computer system.’” (App. Br. 6). Thus, according to Appellants, Wick fails to disclose “a management program installed on the computer system which is responsive to the command from the management system.” (*Id.*).

However, Appellants’ argument that “management” is defined in Appellants’ Specification as “to evaluate, monitor and correct problems on [a] managed computer system” is not commensurate with the claimed

invention. The term “management” cannot be confined to a specific embodiment set forth in Appellants’ Specification. Appellants’ claims simply do not place any limitation on what “management” is to be, to represent, or to mean, other than that the management program is responsive to the command from the management system.

We agree with the Examiner’s position as to Wick disclosing the “management” feature beginning at page 4 of the Answer and the Examiner’s corresponding responsive arguments beginning at page 8 of the Answer. The Examiner found that Wick’s detection of a user’s availability and sending a responsive message is “equivalent to responsive to the command.” (Ans. 8).

In Wick, upon occurrence of a specified event indicating the status of a user, a pounce is executed and a predetermined message is sent. (FF 1-2). We agree with the Examiner that such pounce and sending of the message is responsive to a command from a management system.

In the Reply Brief, Appellants add the argument that “the on/off status of a user in Wick is not for a management program that ‘is responsive to’ it.” (Reply Br. 2). However, as discussed above, one of ordinary skill in the art would have understood that a program that is executed upon occurrence of an on status, such as that of Wick, is a program that “is responsive to” the on status.

In the Reply Brief, Appellants also add that “the on/off status in Wick is not even an active message posted by a user.” (Reply Br. 2). However,

such argument is not commensurate with the claimed invention. No where in Appellants' claim does such "*active message posted by a user*" feature appear. We agree with the Examiner's finding that Wick discloses the "command from a management system posted thereto" feature, beginning at page 4 of the Answer.

As to the other recited elements of claim 1, Appellants provide no arguments to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting independent claims 1, 10, and 14 and claims 2-7, 9, 11, 12, 15-18, and 20, depending therefrom, under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a)

As to claims 8, 13, and 19, Appellants provide the same argument as claims 1, 10, and 14 from which they respectively depend.

We see no deficiencies regarding Wick and MacGregor, as discussed above regarding claims 1, 10, and 14. Therefore, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 8, 13, and 19 under 35 U.S.C. § 103(a).

CONCLUSIONS OF LAW

(1) Appellants have not shown that the Examiner erred in finding that claims 1-7, 9-12, 14-18, and 20 are unpatentable over the teachings of Wick.

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(2) Appellants have not shown that the Examiner erred in finding claims 8, 13, and 19 are unpatentable over the teachings of Wick and MacGregor.

(3) Claims 1-20 are not patentable.

DECISION

The Examiner's decision rejecting claims 1-7, 9-12, 14-18, and 20 under 35 U.S.C. § 102(e) and claims 8, 13, and 19 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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